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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,543	08/15/2001	Kazunori Muta		1245

23628 7590 07/15/2004
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EXAMINER

HOWARD, SHARON LEE

ART UNIT PAPER NUMBER

1615

DATE MAILED: 07/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/913,543

Applicant(s)

MUTA ET AL.

Examiner

Sharon L. Howard

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,5 and 7-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,5,7-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

Examiner acknowledges receipt of one month extension of time and response filed on 1/21/03.

Claims 1-8 are pending.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 and newly added claims 9 and 10 remain rejected under 35 U.S.C. 103(a) as being unpatentable over JP 57-206614 in view of JP 61-260014.

The JP '614 teaches an adhesive preparation in the form of a sheet. JP '614 discloses an adhesive preparation in the form of a sheet. The document shows continuous volatilization and dispersion of constant quantities of moisture, and therefore dissipates a corresponding quantity of heat of evaporation from the skin and gives a cooling sensation (see the control sample).

JP '614 does not teach a glycol or a polyhydric alcohol.

However, JP '014 discloses a hydrous patch comprising an adhesive preparation containing polyhydric alcohol which also gives a persistent cooling sensation when applied to the skin.

It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be

used for the very same purpose. **(See In re Kerkhoven, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980)).**

The expected result is a sheet-form preparation comprising a polyhydric alcohol.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of JP '614 in view of JP '014. One having ordinary skill in the art would have been motivated to prepare a third composition by including polyhydric alcohol into the preparation of JP '614, because the third composition can be used for the same purpose of giving a cooling or refreshing effect to the skin.

Response to Arguments

Applicant's arguments filed 4/19/04 have been fully considered but they are not persuasive. Applicant argues that in the instant case the compositions of the prior art, while allegedly are useful for the same purpose (to give a cooling sensation), are not composed of the same ingredients. The compositions are based on different formulations, and the combination of the prior art compositions does not provide Applicant's claimed invention. There is no evidence presented by the Examiner suggesting that a single component (polyhydric alcohol) can be selected from the adhesive preparation of JP '014 for addition into the adhesive preparation of JP '614. Both the JP '614 and the JP '014 references fail to disclose the glycol feature of claim 1 as amended (1-50 wt% of a glycol). It is clear that one of ordinary skill in the art would have no motivation to combine these two references, at least for the reason that neither provides for the presence of a glycol in the preparations.

In response to applicant's arguments, there is motivation to combine both the JP '614 and the JP '014 references. The composition of the JP '614 reference has been shown to be useful as an adhesive preparation in the form of a sheet (see the control sample), and the composition of the JP '014 reference has been shown to be useful as a hydrous patch containing an adhesive preparation and a polyhydric alcohol. Also, in claim 1, which has been currently amended, does not not rebut the argument of the mixing of two components.

The rejection under 35 U.S.C. 103(a) is maintained for reasons set forth above.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

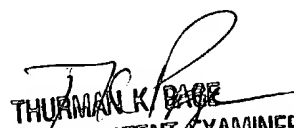
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharon L. Howard whose telephone number is (571) 272-0596. The examiner can normally be reached on 9:00am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sharon Howard
June 30, 2004



THURMAN K. PAGE
SUPERVISORY PATENT EXAMINER
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